

## REMARKS

Claims 1 – 211 are pending. Of these claims 1, 64, 159, 182 and 197 are independent.

The claims are generally directed to methods and apparatus for automatically preparing communications offers of financial products/services. The single rejection under § 103 based on (De Lapa – US Patent No. 5,822,735) is addressed by both amendment and traverse as described below. The prior arguments of record are also incorporated by reference herein.<sup>1</sup>

### INDEPENDENT CLAIM 1

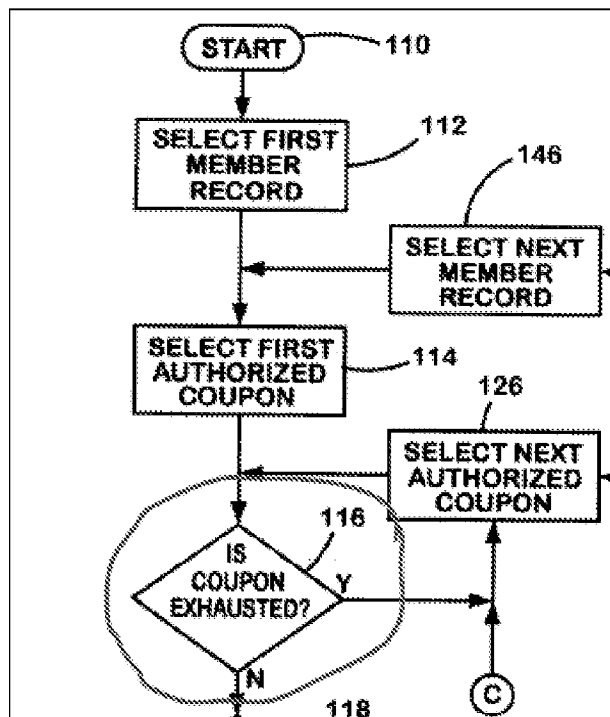
Independent claim 1 has been amended as noted above to further clarify the differences over the De Lapa reference. Reconsideration is respectfully requested.

De Lapa teaches away from a process that uses “...at least one or more financial products or financial services that is at least considered for offering to each entity...” in an entity set.

As noted before, De Lapa's system generally operates by selecting an individual member record, and then attempts to fill a coupon sheet for such person. The coupons are subject to a finite supply, which means that with a supply of N coupons the Nth+1 customer cannot receive a specific coupon if N copies of such coupon have already been printed for the prior N other prior customers. Here is the pertinent feature from De Lapa which relates to such point:

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<sup>1</sup> See e.g., REQUEST FOR RECONSIDERATION/PETITION TO WITHDRAW THE FINALITY OF THE OFFICE ACTION filed in the instant case on September 6, 2005; and ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW filed November 3, 2005.



Once the last coupon of a particular type is sent to a customer, there is no ability or means identified to offer such coupon to a subsequent customer. That this is true can be confirmed quite easily from reviewing the operation of De Lapa's program at col. 14, ll. 30+. Thus, in the above figure, when the coupon is exhausted at step 116, the "next" authorized coupon must be considered at step 126.

What this means is that it is impossible within the De Lapa reference to meet the limitation of claim 1, which states that:

**...said financial product/service set includes at least one or more financial products or financial services that is at least considered for offering to each entity in said entity set.**

In other words, one aspect of the disclosed method works from a product perspective, i.e., by starting with one more financial products, and trying to find appropriate recipients for the same. For these items in the financial product/service set, at least one is designated to be considered for offering to each entity in said entity set. In a real world example, this means that individuals identified as candidates for a particular life insurance policy, mortgage, credit card, etc. are at least guaranteed that they will at least be considered for such financial product/service on an equal footing with other potential individuals, and if applicable will be offered such products.

In contrast, De Lapa freely acknowledges that he is doing exactly the opposite: he starts off with a member list, and then tries to find appropriate coupons from a remaining limited subset of the original coupons.

**“...the cyclic coupon selection mailing routine selects coupons by consumer, rather than vice versa”** See, e.g., col. 15, ll. 46+ (emphasis added).

There can be no clearer indication of non-obviousness: De Lapa plainly teaches directly away from the method set out in amended claim 1. This completely different algorithm leads to a very different result: namely, by the time De Lapa starts to consider coupons for later customers in the database, these persons are constrained in that they are only being offered a now more limited and reduced selection set of items, not because such item are more appropriate for such persons, but solely because of coupon exhaustion.

Consequently for any particular consumer, De Lapa only ever looks at a very narrow subset of coupons that may be pertinent to that person's interests – in fact, just enough to fill out the coupon sheet noted in Figure 2. It is incontrovertible therefore that De Lapa teaches away from solving the problem of communicating the most appropriate set of items to a particular customer. A continuing rejection for obviousness is fundamentally unsupportable under such circumstances. See In re Grasselli, 713 F.2d 731, 218 USPQ 769, 779 (Fed. Cir. 1983).

Furthermore, according to the claimed invention, one useful consideration is that if there is an appropriate financial product for a particular entity, then it should be at least considered for offering to such entity (as well as any other entities). This should occur whether the entity is the first or the last in the entity set, i.e., without regard to the order in which the entity is processed.

Thus, at this point, for De Lapa to be relevant, the Examiner would have to modify the operation of such system to be 180° opposite from what is stated as the primary logic of such routine – selecting coupons by consumer. As the Examiner is undoubtedly aware, if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); MPEP 2143.01 Moreover given its express teachings to the contrary such modification would likely render De Lapa unsatisfactory for its intended purpose, further demonstrating that there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

De Lapa does not disclose a process in which “...offers of any single financial product or said financial service to said persons can be varied from person to person”

In the De Lapa reference the coupon sheets are varied, such that a first person may receive a different set of coupons than a second person. As the Examiner suggests, hypothetically speaking a first person may get a \$5 coupon for Brand X, while a second person may get a \$10 coupon for Brand X.

However, De Lapa says nothing about tailoring an offer of a single coupon so that an offer can vary from person to person. In other words, in the above hypothetical in DeLapa a \$5 (or \$10) coupon for Brand X sent to consumer #1 has exactly the same textual content and is presented in exactly the same way as any other \$5 coupon for Brand X to any other consumer. There is no differentiation made according to the person receiving the offer for the single coupon. In contrast, in the present invention, the ability to customize and personalize such offerings if need be is a significant advantage.

Again the Examiner suggests that De Lapa presents offers differently to different persons, based on the fact that some persons get a coupon for Brand X at a first face value, while others get another coupon for Brand X at a second higher face value. Nonetheless the Examiner can plainly note that: (1) these are coupons, not financial products/services; (2) these are clearly two different coupons in De Lapa, and not a single coupon presented in two different ways. That several identical coupons are transmitted at once does not change the fact that each coupon is still the same for each person. That the different value coupons are treated as “different” coupons is apparent from the teaching in De Lapa that all coupons are identified with unique UPC codes:

Coupons are currently being encoded with bar codes, such as UPC codes, which are provided for the purpose of identifying the manufacturer and brand of the product being discounted, the family of goods to which the product belongs **and the value of the discount...**” See e.g. De Lapa at col. 2, ll. 6 – 10. (emphasis added)

In short, the hypothetical individual \$5 coupon and \$10 coupon for Brand X are not a single “financial product or service.” According to De Lapa it is incontrovertible that the different value coupons would have different UPC codes. Thus De Lapa does not in fact allow for using variable information which:

“...includes at least partially a customized identification, specification and/or promotion of said financial product or said financial service for said entity wherein said variable information may vary among entities being offered said financial product or said financial service and such that **offers of any single** financial product

or said financial service to said persons may vary from person to person....  
(emphasis added)

De Lapa only discloses the use of identical content for selling a particular coupon; the present invention allows for the possibility of a partially customized identification, specification and/or promotion of a financial product/service, which is a significant benefit in mass marketing applications – particularly those involving sophisticated products/services.

De Lapa does not disclose a process of “...automatically generating the communication for said entity **if it is determined to offer** said financial product or said financial service to said entity”

As pointed out several times in the record, De Lapa always sends a coupon sheet to every customer. Again, that is because, as noted above, De Lapa's focus is on exhausting a set of coupons from manufactures based on working through a customer list. In contrast, the claimed invention does not send any product/service offers to a given customer if it is determined that none of the products are appropriate for the person. This is clear from the following language of claim 1:

“automatically generating the communication for said entity *if it is determined to offer said financial product or said financial service to said entity*”.

As De Lapa works exactly opposite to the logic of this claim, Applicant again submits that this is yet further conclusive proof of non-obviousness.

#### Traverse concerning Official Notice on Financial Products/Services

The Applicant further notes that the Examiner has relied on “official notice” that financial products/services are well-known in the art, and on that basis rejected the claims. Applicant does not dispute that financial products/services are known in the art. However, they have not been the subject of the type of customized mass automated processes of the type set out in the present disclosure. Thus this rejection is traversed on the basis that the Examiner has still not demonstrated how/why it would have been obvious - even if such financial products/services were well-known – to modify De Lapa to incorporate the same.

It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697; Ahlert, 424 F.2d at 1092, 165 USPQ 421.

Here the Examiner has not explained in the record what teaching, suggestion or motivation exists for a person skilled in the art to modify De Lapa to utilize financial products/services. Indeed, from all indications, the Examiner has merely relied on hindsight - using the Applicant's disclosure – to argue that it would have been obvious to treat financial products/services in the manner disclosed in De Lapa. Such use of the Applicant's disclosure as a blueprint however is not a permissible basis for a § 103 rejection. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

According Applicant submits that claim 1 as amended clearly distinguishes over De Lapa for several reasons set forth above. Reconsideration and allowance are earnestly requested.

### **DEPENDENT CLAIMS 2 – 63**

Dependent claims 2 – 63 are allowable for at least the reasons set forth above for claim 1. Moreover, at least some of these claims do not stand or fall with claim 1 and should be allowable for the reasons set forth below.

#### Claims 2 – 11

To wit, the Examiner rejected claims 2 – 11 as follows:

With respect to claims 2-11, 65-73 De Lapa further teaches storing said data in one or more databases and collecting additional data from one or more sources, and updating said one or more databases with said additional data accessible via modem (col. col. 7, lines 61-67)

See Office Action of May 5, 2005. While this section of the Office Action discloses a part of De Lapa marginally related to claims 2 -4, it notably lacks any explanation of the basis for a rejection of the following remaining claims:

Claim 5: ... wherein step (2) comprises automatically determining said variable information using decision information, step (2) further comprising: applying said decision information to retrieve or select information, said retrieved or selected information to be included in said communication.

Claim 6: ... further comprising: inputting data from one or more sources; wherein said variable information is generated from said data.

Claim 7: ..... wherein step (2) comprises: processing data according to decision information to determine said variable information.

Claim 8: .... wherein step (2) further comprises: processing said variable information according to other decision information to refine said variable information.

Claim 9: ....wherein step (2) further comprises: automatically modifying on a real-time basis said variable information so as to be more desirable to said entity.

Claim 10: .... using outbound or inbound telemarketing to obtain data pertaining to said entity; and customizing said communication for said entity based on said data pertaining to said entity.

Applicants have carefully considered the sections identified in De Lapa by the Examiner and find nothing relating to the above limitations. For example, and without limiting the discussion, in claim 9, there is absolutely nothing in De Lapa discussing modifying variable information on a “real-time” basis. If the Examiner believes there is something there, she is respectfully requested to point it out more particularly so the merits of the rejection can be discussed and responded to meaningfully. As the MPEP states:

It is important for an examiner *to properly communicate the basis for a rejection* so that the issues can be identified early *and the applicant can be given fair opportunity to reply*. MPEP 706.02(j) (emphasis added)

The reason for this is to avoid piecemeal examination, which is also discouraged by the MPEP:

Piecemeal examination should be avoided as much as possible. ....Where a major technical rejection is proper, *it should be stated with a full development of reasons* rather than by a mere conclusion coupled with some stereotyped expression. MPEP 707.07(g) (emphasis added)

In the meantime, since the Office Action contains no specific hint of where such limitations are disclosed or suggested in De Lapa, Applicant submits that the present §103 rejections for such claims cannot be sustained in the face of a complete lack of evidence. One of the key criteria needed to establish *prima facie* obviousness of a claimed invention is that all the claim limitations must be taught or suggested by the prior art. In *re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In *re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). *See, e.g.*, MPEP 2143.03; 706.02(j).

This has clearly not been done for claims 2 – 11 and thus the rejection should be withdrawn.

#### Claims 12 – 52

These claims are allowable for at least the reasons set forth above for claim 1. Moreover, despite the fact that claims 12 – 52 set out an additional 40 separate inventions and limitations, the sole rejection leveled against such claims to date is the following:

With respect to claims 12-62, 74-115, 132-136, 142 De lapa further teaches selecting the format for the communication and said selected delivering medium (Figure 3).

Again while the above section of De Lapa arguably pertains to some portion of these claims, the Office Action skips over large numbers of separate inventions defined in remaining claims 24 – 52. Thus the Office Action makes no mention of anything germane to the following:

Claim 24: ... constructing said communication based on data pertaining to said entity.

Claim 25: ....delivering said communication to said entity based on data pertaining to said entity.

Claim 26: ....selecting a plurality of delivery mediums that will be used to deliver the communication to said entity.

Claim 28: ....automatically generating a communication for an entity based on one or more pre-defined events.

Claim 29: ....automatically generating a communication for an entity based on a set of predetermined criteria.

Claim 31: ....selectively placing at least some content in blank spaces of said communication.

Claim 32: .....selecting a subset of entities from a set of available entities; and performing steps (1), (2), and (3) for only said selected subset of entities.

Claim 34:... wherein part of said communication comprises variable information.

Claim 35: ....wherein said communication only includes variable information.



Claim 37: ....wherein said communication format is customized for said entity.

Claim 38: .....generating said communication format based on client demographics.

Claim 43: .... wherein said document is an electronic document.

Claim 45: .....delivering said communication and reply means to said entity.

Claim 46:... wherein said reply means enable said entity to conduct a transaction pertaining to said financial product or financial service.

Claim 47: .... wherein said reply means enable said entity to obtain more information pertaining to said financial product or financial service.

Claim 48:..... wherein said reply means enable said entity to purchase said financial product or financial service, as a one-step sales process.

Claim 50:..... wherein said reply means is part of said communication.

Claim 51: ...wherein step (2) comprises: determining said variable information by performing one or more calculations.

Claim 52: ...wherein step (a) comprises: performing calculations based on data pertinent to said entity to at least one of select, design, and price at least one of a financial product and a financial service.

As with the discussion of claims 2 – 11, Applicants have carefully considered the sections identified in De Lapa by the Examiner and find nothing relating to the above limitations. For example, and without limiting the discussion, in claim 26, there is absolutely nothing in De Lapa discussing a “plurality of delivery mediums,” or in claim 31 – “selectively placing at least some content in blank spaces...” or a “reply means” (claims 45 - 50) etc., etc. Again should the Examiner believe there is something there, she is respectfully requested to point it out more particularly so the merits of the rejection can be discussed and responded to meaningfully meaningfully and as required by MPEP 706.02(j) and 707.07(g) to avoid further piecemeal examination.

Since there is no substantive citation in the current record pertaining to the above limitations, Applicant submits that the present §103 rejections for such claims cannot be sustained. For this reason the rejections should be withdrawn.

### Claims 53 - 58

These claims were rejected based on the same disclosure relied on for claim 1. They are allowable for at least the reasons set forth above for claim 1. Moreover Applicant has reviewed the areas in De Lapa highlighted by the Examiner and notes that it does not in fact teach anything pertaining to the following:

Claim 53: ...wherein step (2) comprises: determining whether to offer one or more particular financial products or financial services to said entity.

Claim 54: .... wherein step (2) further comprises: calculating one or more amounts of said one or more particular financial products or financial services to offer to said entity.

Claim 55: ....wherein step (2) further comprises: calculating costs of said one or more amounts of said one or more particular financial products or financial services to offer to said entity.

Claim 56: .... wherein (2) comprises: identifying any types of financial products or financial services that said entity needs; and determining, for each type needed by said entity, particular financial products or financial services to offer to said entity.

Claim 57: ....wherein step (2) comprises: identifying whether the entity has need for any pre-selected types of financial products or financial services; and determining, for each type needed, particular financial products or financial services to offer to said entity.

Claim 58: ....using demographics to at least one of select, design, and price at least one of a financial product and a financial service.

As with the discussion of claims 2 – 52, Applicants have carefully considered the sections identified in De Lapa by the Examiner and find nothing relating to the above limitations. For example, and without limiting the discussion, in claim 53: De Lapa does not “determine whether to offer”; once the member is in the member database, that person receives coupons irrespective of whether such coupons are appropriate for that individual. Similarly in claims 54, 55 there is absolutely nothing in De Lapa discussing “calculating” either amounts or costs; or in claims 56 – 57 – identifying needs of the customer, or in claim 58 (demographics used).

Again should the Examiner believe there is something there, she is respectfully requested to point it out more particularly so the merits of the rejection can be discussed and responded to meaningfully and as required by MPEP 706.02(j) and 707.07(g) to avoid further piecemeal examination. As there is no substantive citation in the current

record pertaining to the above limitations, Applicant submits that the present §103 rejections for such claims cannot be sustained. For this reason the rejections should be withdrawn.

#### Claims 59 - 63

These claims were rejected based on “official notice.” Again the Applicant does not dispute that these claims are directed to more specific financial service/product embodiments. Nonetheless neither De Lapa nor any other reference cited by the Examiner provides any teaching, suggestion or hint to incorporate financial products/services into the kind of process set out in amended claim 1.

#### **INDEPENDENT CLAIM 64**

Independent claim 64 has been amended in similar fashion to claim 1 and should be allowable for substantially the same reasons.

#### **DEPENDENT CLAIMS 65 - 158**

With respect to dependent claims 65 – 158: these should be allowable as well based on the discussion above for dependent claims 2 – 63.

#### **INDEPENDENT CLAIM 159**

Independent claim 159 has been amended in similar fashion to claim 1 and should be allowable for substantially the same reasons.

#### **NEW CLAIMS 160 – 210**

New claims 160 – 163 depend from claims 1 and 64 and should be allowable for the reasons set forth above. Such claims further distinguish on the basis that they pertain to methods of ensuring that communication offers comply with various applicable compliance standards, regulations, etc. De Lapa’s coupons do not include such information. Support for such claims can be found in the specification at among other places, page 27, ll. 18+ .

New claims 164 – 181 depend from claim 159 and should be allowable for the reasons set forth above. Such claims are substantially identical to counterparts already submitted for claims 1 and 64.

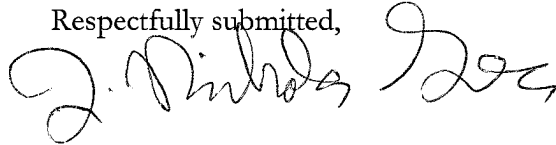
New independent claims 182 and 197 cover similar and additional embodiments to

those covered in the other independent claims. They should be allowable for many of the same reasons set forth above. The claims depending thereon (183 – 196 and 198 – 211 respectively) also mirror previously submitted dependent claims and should be allowable for the reasons set forth above.

## CONCLUSION

For the reasons set forth above, Applicant requests reconsideration of the present rejection and allowance of the application. A petition and fee for a three month extension of time is also enclosed. Please charge such fees and any other fees due for the additional new claims to deposit account no. 501 – 244.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "J. Nicholas Gross", written in a cursive style.

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